

PATENT

Atty Docket No.: 10003469-1
App. Ser. No.: 09/864,242

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Currently, claims 1-3, 7, 8, 12 and 18-20 are pending in the present application of which claims 1, 7 and 18 are independent. Claims 13-17 have been cancelled.

Claims 1-3, 7, 8, 12 and 19-20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Erlin (U.S. Patent Number 6,275,991) as applied to claims 1-8, 12, and 18-20, and further in view of Stewart et al. (U.S. Patent Number 6,571,221). Claim 18 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stewart et al. as applied to claims 1-3, 7, 8, 12 and 19-20, and further in view of Erlin. The above rejections are respectfully traversed for at least the reasons set forth below.

Summary of Telephonic Interview Conducted February 8, 2005

Applicant acknowledges receipt of the Interview Summary mailed with the Office Action dated February 17, 2005. As set forth in the Interview Summary, agreement was reached during the telephonic interview conducted February 8, 2005 that claims 13-17 would be cancelled because claims 13-17 are directed to a portable digital assistant. Claims 13-17 have accordingly been cancelled.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-3, 7, 8, 12 and 19-20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Erlin as applied to claims 1-8, 12, and 18-20, and further in view of Stewart et al. This rejection is respectfully traversed because Erlin and Stewart et al., considered singly or in combination, fail to teach or suggest the claimed invention as set forth in independent claims 1 and 7, and their dependent claims.

Independent claim 1 recites "storing a digital signature of a user in a memory of a remote control," "performing said electronic transaction" and "transmitting said digital signature of said user from said remote control to complete said electronic transaction, wherein the digital signature remains stored in the memory after the transaction is completed or canceled."

Independent claim 7 recites "a controller configured to transmit a digital signature" and "wherein the digital signature remains stored in the memory after the transaction is completed or canceled."

Erlin discloses a remote control unit including a transmitter and a method for transmitting signals to a remote interactive location such as a television set or a TV cable remote control box (Abstract). Erlin, however, fails to teach or suggest "storing a digital signature of a user in a memory of a remote control," "performing said electronic transaction"

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and "transmitting said digital signature of said user from said remote control to complete said electronic transaction, wherein the digital signature remains stored in the memory after the transaction is completed or canceled" as claimed. The Office Action states

Erlin discloses the claimed invention except for the storing a digital signature of a user in a memory. However, Erlin does teach about the use of Data Encryption Standard (DES), Personal Identification Number (PIN) Encryption Key (PEK) and two main encryption functions, PIN translations and PIN verifications. (Office Action, page 3)

The rejection alleges that the DES, PIN and PEK constitute a digital signature stored in a memory of a remote control. Erlin, however, fails to teach or suggest that the DES, PIN and the PEK constitute a digital signature stored in the memory of a remote control unit. Instead, a set top box includes the PEK, and the set top box transmits the PEK which is used to code the PIN (Column 7, lines 20-25). Erlin thus fails to teach or suggest storing a digital signature in a memory of a remote control unit and fails to teach or suggest "wherein the digital signature remains stored in the memory after the transaction is completed or canceled."

Stewart et al. fails to remedy the deficiencies of Erlin. Stewart et al. discloses a portable computing device (PCD) that includes a memory which stores a digital certificate (Column 11, lines 20-30). Stewart et al. however, fail to teach or suggest "transmitting said digital signature of said user from said remote control to complete said electronic transaction, wherein the digital signature remains stored in the memory after the transaction is completed or canceled" as claimed. Instead, the digital certificate disclosed by Stewart et al. is used for user authentication and security (Column 11, lines 29-31), but the digital certificate is not transmitted from a remote control to complete an electronic transaction. Thus, neither Erlin nor Stewart et al. whether alone or in combination, teach or suggest all the features of independent claims 1, 7 and 18, and their dependent claims.

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In addition, the Applicant asserts that there is no suggestion or motivation to combine the teachings of Erlin and Stewart et al. The Office Action states that

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the television remote control unit DES encryption chip, Fig. 3, 65, of Erlin with the storing a digital signature of a user in a memory of Stewart because a digital signature, and a PEK both serve the same function as authenticating a user. (Office Action, page 3, and pages 4-5)

The combination of Erlin and Stewart et al., however, would not render obvious Applicant's claimed invention. Erlin teaches directly away from Applicant's claims, wherein independent claims 1, 7 and 18 each recite "wherein the digital signature remains stored in the memory after the transaction is completed or canceled." In particular, Erlin discloses that

it is *not desirable* to permanently store any such ATM type transaction information, including the PIN and PEK codes, within the remote control unit after the transaction is completed (in order to minimize the risk of unauthorized access to the PIN/PEK information) (Column 8, lines 12-17)

Thus, Erlin teaches away from Applicant's claimed invention because Erlin discloses that it is *not desirable* to store transaction information, including PIN and PEK codes, within a remote control unit after a transaction is completed (Column 8, lines 12-17). Thus, one of ordinary skill in the art would not have been motivated to combine the teaching of a memory which stores a digital certificate, as disclosed by Stewart et al., with the disclosure of Erlin, because Erlin discloses that it is *not desirable* to store transaction information within a remote control unit after a transaction is completed.

In addition, Stewart et al. relates to a network communication service, whereas Erlin relates to a transmitter with a magnetic-stripe card reader. There is no suggestion or motivation to store the digital certificate of Stewart et al., which is used for allowing access to

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a network (Stewart et al., Column 2, lines 55-62), with the remote control unit of Erlin, which is used for communicating with a receiver.

With regard to independent claim 7, neither Erlin nor Stewart et al., whether alone or in combination, teach or suggest the features of independent claim 7, for at least the reasons set forth above. In addition, the Office Action admits that Erlin fails to teach or suggest a wireless transceiver (Office Action, page 5).

At least by virtue of Erlin's and Stewart et al.'s failure to teach or suggest the above identified features of independent claims 1, 7 and 18, and because of the lack of suggestion or motivation to combine Erlin and Stewart et al., a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of those claims. Claims 2-3 depend from allowable claim 1, and claims 8 and 12 depend from allowable claim 7. These dependent claims are also allowable at least by virtue of their dependencies.

Applicants respectfully submit that the rejection of claims 19 and 20 is improper. Claims 19 and 20 were improperly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Erlin, and further in view of Stewart et al. Claims 19 and 20 depend from independent claim 18, and claim 18 was not rejected in the Office Action as being unpatentable over Erlin in view of Stewart et al. Instead, claim 18 was rejected over Stewart et al. in view of Erlin in a separate rejection on page 6 of the Office Action. Thus, the rejection of claims 19 and 20 must be withdrawn and any new rejection cannot be made final.

Claim 18 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stewart et al. as applied to claims 1-3, 7, 8, 12 and 19-20, and further in view of Erlin. This rejection is respectfully traversed because it is improper to apply Stewart et al., as applied to

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claims 1-3, 7, 8, 12 and 19-20, as a reference in a rejection of independent claim 18.

Dependent claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Erlin, and further in view of Stewart et al. It is improper to apply Stewart et al. "as applied to claims 19-20" in a rejection of independent claim 18 because claim 18 does not depend from claims 19 and 20. Thus, the rejection must be withdrawn.

Furthermore, Stewart et al. and Erlin, considered singly or in combination, fail to teach or suggest the features recited in independent claim 18.

Independent claim 18 recites "means for transmitting said digital signature of said user from said memory means to the Internet terminal for completing said electronic transaction, wherein the digital signature remains stored in the memory means after the transaction is completed or canceled."

The deficiencies of Stewart et al. and Erlin are set forth above. Stewart et al. fails to teach or suggest "means for transmitting said digital signature of said user from said memory means to the Internet terminal for completing said electronic transaction, wherein the digital signature remains stored in the memory means after the transaction is completed or canceled" as claimed. Instead, Stewart et al. discloses storing a digital certificate for user authentication and security on a network. The Office Action admits Stewart et al.'s failure to teach or suggest means for initiating an electronic transaction (Office Action, page 7). The digital certificate disclosed by Stewart et al. is stored in a portable computing device (PCD) to allow a user to access a network. The digital certificate is not, however, transmitted from a PCD to an Internet terminal for completing an electronic transaction, nor is the digital certificate stored in a memory means after the electronic transaction is completed or canceled.

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The digital certificate stores sponsorship and demographic information of a user (Abstract), but the digital certificate is not transmitted for completing an electronic transaction.

Erlin fails to remedy the deficiencies of Stewart et al. Erlin fails to teach or suggest "means for transmitting said digital signature of said user from said memory means to the Internet terminal for completing said electronic transaction," as claimed. Neither the PIN, PEK, or the DES encryption clip which is used for encryption, as disclosed by Erlin, constitutes a digital signature stored in a memory of a remote control unit. In addition, neither the PIN, PEK, or the DES encryption clip constitute a digital signature for completing an electronic transaction. Moreover, Erlin also teaches away from Applicant's claimed invention because Erlin discloses that it is *not desirable* to store transaction information, including PIN and PEK codes, within a remote control unit after a transaction is completed (Column 8, lines 12-17). Thus, one of ordinary skill in the art would not have been motivated to combine the teaching of a memory which stores a digital certificate, as disclosed by Stewart et al., with the disclosure of Erlin, because Erlin discloses that it is *not desirable* to store transaction information within a remote control unit after a transaction is completed. There is also no suggestion or motivation to store the digital certificate of Stewart et al., which is used for allowing access to a network (Stewart et al., Column 2, lines 55-62), with the remote control unit of Erlin, which is used for communicating with a receiver.

At least by virtue of Erlin's and Stewart et al.'s failure to teach or suggest the above identified features of independent claim 18, and because of the lack of suggestion or motivation to combine Erlin and Stewart et al., a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of independent claim 18.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

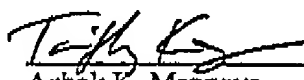
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Douglas WEIGEL

Dated: May 17, 2005

By



Ashok K. Mannava

Registration No.: 45,301

Timothy Kang
Reg. No. 46,423

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 880-5270 (facsimile)